REMARKS

Claims 1, 2, 10-13, 15, 17, 20, and 22 have been amended. Claims 14 and 21 have been cancelled. In addition, the second occurrence of claim 21 has been cancelled and re-presented as claim 24 to correct the numbering of the claims. Therefore, claims 1-13, 15-20, and 22-24 are pending in the case. Further examination and reconsideration of pending claims 1-13, 15-20, and 22-24 are hereby respectfully requested.

Objections to the Claims:

The claims were objected to because the numbering of the claims was not in accordance with 37 CFR 1.126. The second occurrence of claim 21 has been cancelled and re-presented as claim 24. Accordingly, it is believed that the listing of claims presented herein addresses the objections to the claims.

Section 102(e) Rejections:

Claim 20 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,047,067 to Rosen. (hereinafter "Rosen"). The standard for "anticipation" is one of fairly strict identity. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131. The cited art does not disclose all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

The cited art does not teach a computer-usable carrier medium that includes programming instructions executable on a computational device for maintaining confidentiality as to an identity of a network client and a network host. Amended independent claim 20 recites in part: "[a] computer-usable carrier medium, comprising ...fourth programming instructions executable on the computational device for maintaining confidentiality as to an identity of the network client and the network host." As set forth in the Specification, "[a]lthough the network server may know the identity of the host and the client, the network server does not disclose this information. The network client and the network host remain unknown to each other. In an embodiment, the network client, network host, and network server may all remain unknown to each other." (Specification -- page 17, lines 10-14.) The Specification also states that "[t]he FRC, in turn, collects and dispenses the actual amounts due each entity, further ensuring the

anonymity and the non-repudiability of the process. That is, the payee does not know the identity of the payer, nor does the payer know the identity of the payee." (Specification -- page 19, lines 15-18.) In addition, the Specification states that "[a]lthough the identities of each network member are known to the FRC, the FRC does not disclose this information." (Specification -- page 20, line 29 - page 21, line 1.) Furthermore, the Specification states that "[t]he desired method would maintain security and anonymity for all involved while providing non-repudiatable financial accounting and account resolution." (Specification -- page 7, lines 20-21.)

The present Office Action states that "Official Notice is taken that 'fourth programming instructions executable on the computational device for maintaining confidentiality as to the identity of the network client and the network host' is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made to maintain confidentiality as to the identity of the network client and the network host in order to provide promote consumer confidence in the system by providing security functions." (Office Action -- pages 5-6.)

In contrast, however, Rosen states that "[t]o preserve the integrity of the electronic monetary system, each exchange of electronic money includes, along with other information,...the bank issuing the electronic credit or currency." (Rosen -- col. 4, lines 4-9). Therefore, Rosen discloses that each transaction would include information about the identity of the bank involved in the transaction for integrity purposes, which would promote consumer confidence. As such, Rosen teaches disclosing the identity of at least the bank instead of maintaining the confidentiality as to the identity of the bank. Consequently, it would not have been obvious to one having ordinary skill in the art at the time of the invention to maintain the confidentiality of the identity of the network client and the network host.

Rosen also discloses several methods for transactions between two entities, A and B. However, the examples provided by Rosen teach that the identities of at least one of the parties (and often both of the parties) involved in a transaction are disclosed. For example, Rosen states that "A agrees to exchange with B dollars($) for pounds (£) at an exchange rate of $/£." (Rosen -- col. 16, lines 53-54). Therefore, A must be aware of the identity of B if it agrees to exchange currency specifically with B. Rosen also states that in a point of sale (POS) payment protocol, "A agrees to purchase products or services from B." (Rosen -- col. 19, line 45). As such, Rosen discloses that A knows the identity of B since A agrees to purchase

goods or services specifically from B. Therefore, Rosen teaches that the confidentiality of the identities of parties involved in a transaction is not maintained.

Such a system is similar to those of other electronic commerce systems known in the art such as "digital cash" and "electronic wallet" type systems. For example, in such systems a bank or another financial institution may issue numbers standing for cash or non-transferable electronic assets that cannot be traced back to the recipient of the electronic currency by using techniques such as blinding and double blinding. In this manner, the recipient can purchase goods or services with the numbers or the non-transferable electronic assets without revealing their identity. However, in such systems, the merchant who provides the goods or services to the customer is known to the customer. For example, the customer selects the goods or services as well as the merchant from which the goods and services are being purchased. Therefore, the customer must be aware of the identity of the merchant. As such, the confidentiality of the identity of at least one of the parties involved in a transaction is not maintained in these systems (i.e., the payer knows the identity of the payee). Consequently, such systems do not maintain the confidentiality of a network client and a network host.

In addition, Rosen states that in a setup credit withdrawal process, "A chooses to make a credit update of a particular amount from a particular bank and account." (Rosen -- col. 20, lines 43-44). Since A chooses the bank and the account, the confidentiality of the identity of the bank cannot be maintained during a transaction. In another example, Rosen states that "[t]he process begins when a subscriber identifies him/herself to a customer service representative (CSR) and requests that the CSR link the subscriber's accounts to a money module...CSMHA accesses the identified subscriber's account information from the bank systems." (Rosen -- col. 24, lines 48-55). Therefore, the subscriber's identity must be disclosed to the CSR and the bank in order for the correct accounts to be identified. In addition, confidentiality of the bank's identity is not maintained since the subscriber knows which bank(s) with which he/she has accounts that are being requested. As such, the subscriber's identity must be known to the bank, and the bank's identity must be known to the subscriber.

In yet another example, Rosen discloses a method for claiming lost money. Rosen states that "the claim could be submitted with the subscriber's identity to an issuing bank." (Rosen -- col. 26, lines 46-47). Rosen also states that "[t]he issuing banks can feel confident in replacing lost money because they can monitor the incoming money against fraudulent applications and they have the applicant's identity." (Rosen -- col. 26, lines 58-61). Therefore, in a process for claiming lost money, at least the bank knows the applicant's identity. As a result, the confidentiality of the applicant's identity is not maintained.

Another method for claiming lost notes is disclosed by Rosen in which the subscriber's identity is known to a customer service representative (CSR), which sends the subscriber's identity to a customer service module (CSM). (Rosen -- col. 27, line 36 - col. 28, line 65).

Furthermore, Rosen states that "the method and apparatus of the present invention employ a preferred embodiment in the form of an electronic-monetary system having (1) banks or financial institutions that are coupled to a money generator device for generating and issuing to subscribing customers electronic money including electronic currency backed by demand deposits and electronic card authorizations." (Rosen -- col. 3, lines 23-30). Therefore, the confidentiality of at least the subscribing customers cannot be maintained since the bank cannot issue money, electronic or not, without knowing the identity of the customers. For one, it would be impossible for the bank to determine the correct accounts from which to issue electronic money without knowing the identity of the subscribing customers. In addition, the bank could not maintain secure accounts since without knowing the subscribing customer's identity the bank would provide essentially unrestricted access to each of its accounts (i.e., without the subscribing customer's identity the bank would have to arbitrarily select an account from which to issue funds).

For at least the reasons provided above, Rosen does not teach maintaining the confidentiality of the identities of parties involved in a transaction. Consequently, Rosen cannot teach a computer-usable carrier medium that includes programming instructions executable on a computational device for maintaining confidentiality as to an identity of a network client and a network host, as recited in claim 20. Accordingly, claim 20 is not anticipated by the cited art and removal of the rejection is respectfully requested.

Section 103(a) Rejections:

Claims 1-3, 8-19, and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosen. Claims 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosen in view of the present application U.S. Serial No. 09/751,856 to Harif (hereinafter " the Applicant's disclosure"). Claims 14 and 21 rendering rejection thereto moot. To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), MPEP 2143.01. The cited art does not teach or suggest all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

The cited art does not teach, suggest, or provide motivation for a computer-usable carrier medium that includes programming instructions executable on a computational device for maintaining confidentiality as to an identity of a network client and a network host, as recited in claim 20. Amended independent claim 15 recites a similar limitation. For at least the reasons provided above, Rosen does not teach a computer-usable carrier medium that includes programming instructions executable on a computational device for maintaining confidentiality as to an identity of a network client and a network host, as recited in claims 15 and 20.

In addition, Rosen does not suggest or provide motivation for such a computer-usable carrier medium. For example, Rosen states that "it is an object of the present invention to provide an enhanced EMS system and related methods for economic exchange that is secure from reuse, duplication, and counterfeiting." (Rosen -- col. 3, lines 1-4). As set forth in more detail above, Rosen teaches that the security of the EMS system cannot be maintained unless the identities of the banks and the subscribing customers is made known to the parties involved in a transaction. As such, there is no suggestion or motivation to modify Rosen such that the confidentiality of the identities of the banks and subscribing parties is maintained since such a modification would render the invention of Rosen being modified unsatisfactory for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01.

In addition, Rosen does not suggest the desirability of maintaining confidentiality as to an identity of a network client and a network host. In contrast, Rosen teaches that disclosing information such as the identity of the bank or the subscribing customer in transactions provides a secure EMS system as set forth in more detail above. As such, Rosen teaches away from maintaining confidentiality as to an identity of a network client and a network host. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). MPEP

2143.03. Therefore, even if the invention Rosen can be modified such that the confidentiality of the identity of the network client and the network host can be maintained, the resultant modification is not obvious. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP 2143.01.

The Applicant's disclosure is not "admitted prior art" because nothing in the Applicant's disclosure constitutes an admission that any portion of the Applicant's disclosure is prior art. On the contrary, the Specification states "[t]he following descriptions and examples are not admitted to be prior art by virtue of their inclusion within this section." (Specification -- page 1, lines 20-21). Thus, the Applicant's disclosure cannot be used to reject the presently claimed invention. Assuming for the sake of argument that the Applicant's disclosure can be construed as prior art usable against the claimed invention, the portion of the Applicant's disclosure cited in the Office Action does not teach, suggest, or provide motivation for a computer-usable carrier medium that includes programming instructions executable on a computational device for maintaining confidentiality as to an identity of a network client and a network host, as recited in claims 15 and 20. As such, the Applicant's disclosure cannot be combined with Rosen to overcome the deficiencies therein.

As such, the cited art does not teach, suggest, or provide motivation for a computer-usable carrier medium that includes programming instructions executable on a computational device for maintaining confidentiality as to an identity of a network client and a network host, as recited in claims 15 and 20. Consequently, the cited art does not teach, suggest, or provide motivation for all limitations of claims 15 and 20.

The cited art does not teach, suggest, or provide motivation for a system for enabling electronic commerce in which identities of network members are known only to a financial resolution center. Amended independent claim 1 recites in part: "[a] system for enabling electronic commerce,...wherein identities of the network members are known only to the financial resolution center." For at least the reasons provided above, the cited art does not teach, suggest, or provide motivation for a system for enabling electronic commerce in which identities of network members are known only to a financial resolution center, as recited in claim 1. Consequently, the cited art does not teach, suggest, or provide motivation for all limitations of claim 1.

The cited art does not teach, suggest, or provide motivation for a computer-usable carrier medium that includes first programming instructions executable on a computational device for presenting a financial charge to a financial resolution center which is levied against a network client that remains unknown to the computational device. Independent claim 19 recites in part: "[a] computer-usable carrier medium, comprising first programming instructions executable on a computational device for presenting a financial charge...wherein the financial charge is levied against a network client, and wherein the network client remains unknown to the computational device." For at least the reasons provided above, the cited art does not teach, suggest, or provide a computer-usable carrier medium that includes first programming instructions executable on a computational device for presenting a financial charge to a financial resolution center which is levied against a network client that remains unknown to the computational device, as recited in claim 19. Independent claim 23 recites a similar limitation. As such, the cited art does not teach, suggest, or provide motivation for all limitations of claims 19 and 23.

For at least the reasons set forth above, independent claims 1, 15, 19, 20, and 23, as well as claims dependent therefrom, are asserted to be patentable over the cited art. Accordingly, removal of this rejection is respectfully requested.

In addition, several of the dependent claims are believed to be separately patentable. For example, dependent claim 2 recites in part: "wherein the network members are determined by the financial resolution center." The features of this claim, in combination with the features of independent claim 1 do not appear to be taught or suggested by the cited art. For example, as set forth in more detail above, the invention of Rosen relates to an electronic-monetary system having banks or financial institutions that are coupled to a money generator device for generating and issuing to subscribing customers electronic money. Therefore, in the invention of Rosen, the network members (i.e., the banks and the subscribing customers) would be determined by the accounts that each subscribing member has at each bank. As a result, Rosen cannot teach, suggest, or provide motivation a system in which the network members are determined by a financial resolution center. Consequently, Rosen does not teach, suggest, or provide motivation for several limitations of claim 2.

CONCLUSION

This response constitutes a complete response to all issues raised in the Office Action mailed April 11, 2003. In view of the remarks traversing rejections presented therein, Applicants assert that pending claims 1-13, 15-20, and 22-24 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5468-06500.

Respectfully submitted,

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